



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/392,728	09/09/1999	KLAUS STOCKEMANN	SCH-1550-C1	1685

7590

05/13/2003

ANTHONY J ZELANO
MILLEN WHITE ZELANO & BRANIGAN PC
ARLINGTON COURTHOUSE PLAZA I
2200 CLARENDON BOULEVARD SUITE 1400
ARLINGTON, VA 22201

EXAMINER

WEBMAN, EDWARD J

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 05/13/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/392728

Applicant(s)

STO CKGM ANN

Examiner

WEBMAN

Group Art Unit

1617

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/31/03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-46, 48, 51-53 is/are pending in the application.
- Of the above claim(s) 13, 14, 27, 28, 33-46 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-12, 15-26, 29-32, 48, 51-53 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1617

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-12, 15-26, 52, 53 are rejected under 35 U.S.C. 102(a) as being anticipated by Stockemann et al., DE 4344463A1 ('463) (see IDS of Feb. 09, 2000).

Claims 1-12, 15-26 is not novel over the prior art ('463). See page 2, lines 61 to 68, page 3, lines 42 to 44, page 4, lines 1 to 19, page 5, lines 1 to 10, page 6, examples 1 to 3, claims 1, 3, 5, 6, 8, 9, 11 and 12.

Applicants argue that DE '463 does not teach amenorrhea. However, such is an intended use. Applicants' disclosed dosages for the antagonists (page 9 line lines 20-24) and the gestagens (page 10 lines 23-31) ^{mean} overlap those disclosed in DE '463 (page 4 lines 33-37) and page 5 lines 9-11 respectively. As to the claimed phases, these also are intended uses. DE '463 (examples 1-3, page 6) teaches numbers of dosage units for antagonist and Gestagen that overlap the claimed numbers. In fact, example 1 page 6 in DE '463 is identical to applicants' Diagram 1 on page 14.

As to the now claimed amenhorrea, such must ^b be attained in view of the fact that, as discussed above, the ~~again~~ ^{again} disclosed dosages overlap and the phases (see DE '463 example 1 page 6 and applicants' diagram 1 page 14) are the same. ^{again}

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1617

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 15-26, 29-32, 48, 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stockemann et al., DE 4344463A1 (DE '463) (see IDS of Feb. 09, 2000).

DE '463 is discussed above.

It would have been obvious to use a combination of competitive progesterone antagonist and gestagen as a contraceptive in view of DE '463.

As to the claimed kits, such are well known in the art.

That is, one of ordinary skill, even the layman, is cognizant of the convenience of contraceptive compositions provided in the kit form and the fact such kits are commercially available. Thus, it would be an obvious expedient to make the invention of DE '463 in kit form, including delineating pills in sets of 7 to indicate one week periods of time.

Applicants again argue the intended use of amenorrhea. Applicants also argue that there is no teaching of a kit in DE '463, however, applicants are silent ^{re} regarding the well-known existence of such kits cited above.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Webman whose telephone number is (703) 308-4432. The examiner can normally be reached on Monday to Friday 9 Am 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Padmanabhan can be reached on (703) 305-1877. The fax phone

Application/Control Number: 09/392,728

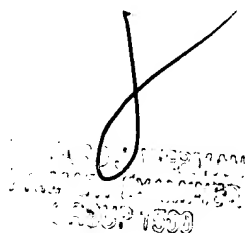
Page 4

Art Unit: 1617

numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Webman/LR
April 22, 2003



A handwritten signature, possibly 'J', is written over a circular stamp. The stamp contains the text 'U.S. DEPARTMENT OF COMMERCE' and 'PATENT AND TRADEMARK OFFICE'.